

### REMARKS

The Official Action dated March 22, 2002 has been carefully considered. Accordingly, the changes presented herewith, taken with the following remarks, are believed sufficient to place the present application in condition for allowance. Reconsideration is respectfully requested.

In the Official Action, an objection was issued relating to the disclosure regarding the following informality: on page 1 of the specification, line 2 of the first paragraph, “§ 199” was erroneously inserted in the place of “§ 119”. By the present amendment, this has been corrected to read “§ 119”. In addition, the Examiner suggested in the Official Action that the following be inserted on page 1, line 1, following “U.S. Application Serial No. 09/512,577”: “now U.S. Patent No. 6,359,017 B1.” This phrase has been added by the present amendment. A version with markings showing changes made is attached. As it is believed that these changes do not involve any introduction of new matter, entry is believed to be in order and is respectfully requested. As the specification has been amended in accordance with the Examiner’s suggestions, it is believed that the objection has been overcome; reconsideration is respectfully requested.

The Examiner required restriction under 35 U.S.C. § 121 between claims 3, 4, 6-8 and 29-37, and claims 38-47. Applicants hereby affirm the election with traverse to prosecute claims 3, 4, 6-8 and 29-37. This election is made with traverse on the basis that continued examination of all claims in this application would not be unduly burdensome. Moreover, the Examiner has not set forth any basis for the restriction requirement between claims 3, 4, 6-8 and 29-37 and claims 38-47. Accordingly, reconsideration of the restriction requirement and examination of all claims 3, 4, 6-8 and 29-47 are respectfully requested.

The Examiner also required election under 35 U.S.C. § 121 of species of third components, food bases, and phytoestrogens. Applicants affirm the elections of the following species: carnitine (claim 30) and cereal (claim 35). However, Applicants respectfully submit that the phytoestrogen election (for claims 3, 8 and 36) has been misrecorded, as Applicants elected genistein, rather than genistin set forth in the Official Action. Thus, Applicants request that the recorded elections be corrected to include genistein, rather than genistin.

Claims 3-4, 6-8, 29-30 and 35-37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Jackson et al (WO 98/04248) in view of Fort (DE 29805782 U1). The Examiner asserted that Jackson et al teach a dietary supplement composition for post-menopausal women containing 1-50 mg phytoestrogen, and asserted that Jackson et al specify genistin. The Examiner further asserted that the Jackson et al composition may be formulated with cereal. The Examiner acknowledged, however, that Jackson et al do not teach compositions incorporating carnitine. The Examiner therefore relied upon the Fort reference, asserting that Fort teaches a dietary cereal containing carnitine. The Examiner further asserted that it would have been obvious to one of ordinary skill in the art to add carnitine to the composition of Jackson et al to achieve the beneficial effects of supplementing the dietary needs for post-menopausal women.

However, as will be set forth in detail below, it is believed that the dietary compositions defined by claims 3-4, 6-8, 29-30, and 35-37 are non-obvious over Jackson et al in view of Fort. Accordingly, this rejection is traversed and reconsideration is respectfully requested.

According to claim 29 of the present application, dietary compositions comprise a mammal food base, a component comprising phytoestrogen, phytoandrogen or a mixture

thereof in an amount sufficient to reduce weight gain normally incurred in the mammal type subsequent to neutering, castration, spaying, ovariectomy or ovari hysterectomy or post menopause, when the dietary composition is administered to a mammal on a regular basis. These dietary compositions further comprise at least one component selected from the group consisting of carnitine, inulin, conjugated linoleic acid and fructose oligosaccharide.

Jackson et al disclose dietary supplements that supply a variety of nutrients to supplement the dietary needs of women in order to prevent or reduce life-stage associated health risks during each principle adult life stage:

Each of the dietary supplements of the [Jackson et al] invention provides a variety of nutrients, including antioxidants to increase the resistance of LDL cholesterol to oxidation, elements to enhance calcium absorption and utilization, nutrients to address iron deficiency anemia, folic acid to prevent fetal neural tube defects, compounds to reduce serum homocysteine and improve the lipid profile and phytoestrogens to reduce the symptoms of menopause, as well as to help in the prevention of osteoporosis, breast cancer and CHD [coronary heart disease]. Furthermore, the amount of each nutrient present varies according to the life stage for which the composition is targeted.

(page 8, lines 6-16). The Jackson et al compositions comprise specified amounts of calcium, magnesium, boron, copper, manganese, zinc, iron, folic acid, chromium, vitamin D, B<sub>12</sub>, B<sub>6</sub>, E, and C, and phytoestrogen in a biologically acceptable carrier.

However, Applicants find no teaching or suggestion in Jackson et al that such compositions should contain a component comprising phytoestrogen, phytoandrogen or a mixture thereof in an amount sufficient to reduce weight gain normally incurred in the mammal type subsequent to neutering, castration, spaying, ovariectomy or ovari hysterectomy, or post menopause, when the dietary composition is administered to a mammal on a regular basis, as required by present claim 29. Furthermore, Applicants find no teaching or suggestion that the aforementioned component comprising phytoestrogen, phytoandrogen or mixture thereof should be included in a dietary composition further

comprising a mammal food base and at least one component selected from the group consisting of carnitine, inulin, conjugated linoleic acid and fructose oligosaccharide, as further required by present claim 29.

References relied upon to support a rejection under 35 U.S.C. § 103 must provide an enabling disclosure, i.e., they must place the claimed invention in the possession of the public, *In re Payne*, 203 U.S.P.Q. 245 (CCPA 1979). The mere fact that prior art could be modified to result in the claimed invention would not have made the modification obvious unless the prior art also suggested the desirability of the modification, *In re Mills*, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). Applicants find no teaching or suggestion in Jackson et al that the Jackson et al compositions would be improved by modifying them along the lines of the present invention. Specifically, Applicants find no teaching or suggestion that compositions disclosed by Jackson et al would serve to prevent weight gain in mammals subsequent to the events listed in claim 29, or that a component comprising phytoestrogen, phytoandrogen, or a mixture thereof should be included in a dietary composition that further comprises a mammal food base and at least one component selected from the group consisting of carnitine, inulin, conjugated linoleic acid and fructose oligosaccharide, as required by present claim 29.

The Examiner relies upon Fort as disclosing a dietary cereal containing carnitine; however, Applicants respectfully submit that the Jackson et al and Fort references are not properly combinable. The Jackson et al reference discloses dietary supplements that are specifically designed to provide nutrients to meet a woman's health needs at particular stages of life. Applicants find nothing in Jackson et al to suggest that modification of the disclosed compositions could be useful to either improve the Jackson et al dietary supplement or to prevent weight gain in mammals subsequent to neutering, castration, spaying, ovariectomy or

ovariohysterectomy, or post menopause, as provided by compositions of the present invention. Fort, in contrast to Jackson et al, discloses a dietary food supplement that, due to the presence of L-carnitin and lecithin, helps to convert body fat into energy and to increase the useful conversion of sugar. Fort is not properly combinable with Jackson et al, however, as one skilled in the art would have recognized the significant differences between the Jackson et al nutritional dietary supplements that are designed to address common health risks and the Fort dietary supplements that are designed to provide energy. No motivation would have existed for one skilled in the art to look to energy providing dietary supplements as taught by Fort to improve the women's dietary supplement of Jackson et al.

The Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select elements from the cited prior art references for combination in the manner claimed, *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). The Examiner cannot pick and choose among the individual elements of assorted prior art references to recreate the claimed invention; rather, the Examiner has the burden to show some teaching or suggestion in the references to support their use in a particular claimed combination, *Smith-Kline Diagnostcs, Inc. v. Helena Laboratories Corp.*, 8 U.S.P.Q.2d 1468, 1475 (Fed. Cir. 1988). Applicants respectfully submit that this burden has not been met.

Even assuming, *arguendo*, that these references are properly combinable, the deficiencies of Jackson et al remain unresolved by the combination with Fort. To establish prima facie obviousness of the claimed invention, all of the claimed limitations must be taught or suggested by the prior art, *In re Royka*, 180 U.S.P.Q. 580 (CCPA 1974). However the deficiencies in Jackson et al remain unresolved by the cited combination with Fort. Applicants find no teaching or suggestion in either Jackson et al or Fort for modifying and

combining their teachings along the lines of the compositions as defined by claim 29 to contain a mammal food base and a component comprising phytoestrogen, phytoandrogen or a mixture thereof in an amount sufficient to reduce weight gain normally incurred in the mammal type subsequent to neutering, castration, spaying, ovariectomy or ovariectomy or post menopause when the dietary composition is administered to a mammal on a regular basis, and at least one component selected from the group consisting of carnitine, inulin, conjugated linoleic acid and fructose oligosaccharide.

As previously stated, references relied upon to support a rejection under 35 U.S.C. §103 must provide an enabling disclosure, i.e., they must place the claimed invention of the public, *In re Payne, supra*. The mere fact that the prior art could be modified would have not made the modification obvious unless the prior art suggested the desirability of the modification, *In re Mills, supra*; *In re Fritch*, 23 U.S.P.Q. 2d 1780 (Fed. Cir. 1992). In order for a combination of references to render an invention obvious, a combination of the teachings of all or any of the references must suggest, expressly or by implication, the possibility of achieving further improvement by combining such teachings along the lines of the invention, *In re Sernaker*, 217 U.S.P.Q. 1, 5 (Fed. Cir. 1983). Applicants find no suggestion, express or implied, relating to the possibility of achieving further improvement by combining the teachings of the cited references along the lines of the present invention. Furthermore, Applicants find no suggestion of desirability for forming a composition as claimed comprising a phytoestrogen, phytoandrogen, or mixture thereof in combination with at least one component selected from the group consisting of carnitine, inulin, conjugated linoleic acid and fructose oligosaccharide.

It is therefore submitted that the dietary compositions defined by claims 3-4, 6-8, 29-30 and 35-37 are non-obvious over the Jackson et al reference in view of Fort, whereby the

rejection under 35 U.S.C. §103 has been overcome. Reconsideration is respectfully requested.

Respectfully submitted,



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**VERSION WITH MARKINGS SHOWING CHANGES MADE**

**In The Specification:**

Paragraph beginning at page 1, under the title and inventor names, has been amended as follows:

**CROSS-REFERENCE TO RELATED APPLICATIONS**

This is a division of U.S. Application Serial No. 09/512,577, filed February 24, 2000, now U.S. Patent No.: 6,359,017 B1, which claims benefit under 35 U.S.C. [§199] § 119 of U.S. Provisional Application Serial No.: 60/121,338, filed February 24, 1999.